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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,332	04/04/2001	Keiichi Taniguchi	Q63917	1802

7590 07/12/2004

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EXAMINER

RAMPURIA, SHARAD K

ART UNIT	PAPER NUMBER
2683	

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/825,332

Applicant(s)

TANIGUCHI, KEIICHI

Examiner

Sharad Rampuria

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Response to Amendment

Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 3, 6, & 10-11 are rejected under 35 U.S.C. 102 (e) as being anticipated by Heinz.

1. Regarding claim 1, Heinz disclosed A portable cellular phone system enabling a user of a portable cellular phone to make use of a stored-type voice message service (Abstract) comprising:

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units to store (16; fig.1; col.7; 25-41), when connection with said portable cellular phone is unable to be made (Abstract), a voice message to be fed to said portable cellular phone and to provide, when connection with said portable cellular phone is able to be made, a notification (MWI flag; col.5; 67-col.6; 7) that said voice message has been stored, to said portable cellular phone. (col.6; 8-18).

3. Regarding claim 3, Heinz disclosed A portable cellular phone system enabling a user of a portable cellular phone to make use of a stored-type voice message service (Abstract) comprising:

a telephone set (10; fig.1) used to send out a voice message to be fed to a user of said portable cellular phone by a manipulation of a caller of said telephone set;

a dialup line (PSTN; 12; fig.1) used to transmit said voice message;

a switching center (MSC; 14; fig.1) used to transmit, when connection with said portable cellular phone is unable to be made, said voice message fed through said dialup line to a voice message storing device (16; fig.1) and to send out, when connection with said portable cellular phone is able to be made, a voice message arrival notifying signal informing (MWI flag; col.5; 67-col.6; 7) that said voice message has been stored, by reading it from said voice message storing device; (col.6; 8-18)

a base station (20; fig.1) used to send out said voice message arrival notifying signal fed from said switching center to said portable cellular phone; and

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said portable cellular phone (30; fig.1) used to receive said voice message arrival notifying signal and to notify said user of said portable cellular phone of receipt of said voice message arrival notifying signal. (col.6; 8-18)

said voice message storing device used to store said voice message transmitted from said switching center and to send out said voice message arrival notifying signal. (MWI flag; col.5; 67-col.6; 7).

6. Regarding claim 6, Heinz disclosed A method for controlling a portable cellular phone system enabling a user of a portable cellular phone to make use of a stored-type voice message service (Abstract) comprising:

steps of storing (16; fig.1), when connection with said portable cellular phone is unable to be made (Abstract), a voice message to be fed to said portable cellular phone and of providing, when connection with said portable cellular phone is able to be made, a notification (MWI flag; col.5; 67-col.6; 7) that said voice message has been stored, to said portable cellular phone. (col.6; 8-18)

10. Regarding claim 10, Heinz disclosed A storage medium (16; fig.1) storing a program for causing a computer to execute functions of a portable cellular phone system (Abstract) enabling a user of a portable cellular phone (10; fig.1) to make use of a stored-type voice message service (102; fig.1), said portable cellular phone system comprising:

units to store (16; fig.1), when connection with said portable cellular phone is unable to be made (Abstract), a voice message to be fed to said portable cellular phone and to provide,

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when connection with said portable cellular phone is able to be made, a notification (MWI flag; col.5; 67-col.6; 7) that said voice message has been stored, to said portable cellular phone. (col.6; 8-18)

11. Regarding claim 11, Heinz disclosed A storage medium (16; fig.1) storing a program for causing a computer to execute functions of a portable cellular phone system (Abstract) enabling a user of a portable cellular phone (30; fig.1) to make use of a stored-type voice message service, (16; fig.1) said portable cellular phone system comprising:

- a telephone set (10; fig.1) used to send out a voice message to be fed to a user of said portable cellular phone by a manipulation of a caller of said telephone set;

- a dialup line (PSTN; 12; fig.1) used to transmit said voice message;

- a switching center (MSC; 14; fig.1) used to transmit, when connection with said portable cellular phone is unable to be made, said voice message fed through said dialup line to a voice message storing device (16; fig.1) and to send out, when connection with said portable cellular phone is able to be made, a voice message arrival notifying signal (MWI flag; col.5; 67-col.6; 7) informing that said voice message has been stored, by reading it from said voice message storing device; (col.6; 8-18)

- a base station (20; fig.1) used to send out said voice message arrival notifying signal fed from said switching center to said portable cellular phone; and

- said portable cellular phone (30; fig.1) used to receive said voice message arrival notifying signal and to notify said user of said portable cellular phone of receipt of said voice message arrival notifying signal. (MWI flag; col.5; 67-col.6; 7)

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said voice message storing device used to store said voice message transmitted from said switching center and to send out said voice message arrival notifying signal. (MWI flag; col.5; 67-col.6; 7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4, 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heinz in view of Brilla et al.

2. Regarding claim 2, Heinz disclosed all the particulars of the claim except a radio packet communication system. However, Brilla teaches in an analogous art, that The portable cellular phone system according to claim 1, wherein said notification that said voice message has been stored is provided to said portable cellular phone by using a radio packet communication system. (col.8; 26-39) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include a radio packet communication system in order to provide transmission of messages via packet switched network.

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4. Regarding claim 4, Heinz disclosed all the particulars of the claim except a radio packet communication system. However, Brilla teaches in an analogous art, that The portable cellular phone system according to claim 3, wherein said base station is so configured as to send out said voice message arrival notifying signal fed from said switching center to said portable cellular phone by using a radio packet communication system. (col.8; 26-39) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include a radio packet communication system in order to provide transmission of messages via packet switched network.

7. Regarding claim 7, Heinz disclosed A method for controlling a portable cellular phone system enabling a user of a portable cellular phone (30; fig.1) to make use of a stored-type voice message service (16; fig.1) comprising:

a voice message sending process of sending out a voice message to be fed to a user of said portable cellular phone by a manipulation of a caller of a telephone set; (10; fig.1; col.5; 67-col.6; 7)

a voice message transmitting process of transmitting said voice message; (PSTN; 12; fig.1; col.3; 63-67)

a switching (MSC; 14; fig.1) process of transmitting, when connection with said portable cellular phone is unable to be made, said voice message fed by said voice message transmitting process, to a voice message storing device (16; fig.1) and of sending out, when connection with said portable cellular phone is able to be made, a voice message arrival notifying signal (MWI

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flag; col.5; 67-col.6; 7) informing that said voice message has been stored, by reading it from said voice message storing device; (col.6; 8-18)

a voice message storing (16; fig.1) process of storing said voice message fed by said switching process and of sending out said voice message arrival notifying signal; (MWI flag; col.5; 67-col.6; 7)

and a voice message arrival notifying process of receiving said voice message arrival notifying signal and of notifying said user of said portable cellular phone of receipt of said voice message arrival notifying signal. (MWI flag; col.5; 67-col.6; 7)

Heinz fails to disclosed all the particulars of the claim except a packet transmitting process. However, Brilla teaches in an analogous art, that said a packet transmitting process of transmitting said voice message arrival notifying signal fed by said switching process to said portable cellular phone. (col.8; 26-39) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include a packet transmitting process in order to provide transmission of messages via packet switched network.

8. Regarding claim 8, Heinz disclosed all the particulars of the claim except a packet transmitting process of transmitting said voice message arrival notifying signal fed by said switching process. However, Brilla teaches in an analogous art, that The method for controlling the portable cellular phone according to claim 7, wherein said packet transmitting process is a process of sending out said voice message arrival notifying signal fed by said switching process to said portable cellular phone by using a radio packet communication system. (col.8; 26-39) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include a packet

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transmitting process of transmitting said voice message arrival notifying signal fed by said switching process in order to provide transmission of messages via packet switched network.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heinz in view of Amin.

5. Regarding claim 5, Heinz disclosed all the particulars of the claim except voice message arrival notifying signal contains information about a caller. However, Amin teaches in an analogous art, that The portable cellular phone system according to claim 3, wherein said voice message arrival notifying signal contains information about a caller and said portable cellular phone has a function to display said information about said caller. (112; fig.2; col.5; 13-31, 40-47, & col.6; 43-57) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include voice message arrival notifying signal contains information about a caller in order to provide a voice mail notification to the subscriber.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heinz & Brilla et al. further in view of Amin.

9. Regarding claim 9, The above combination disclosed all the particulars of the claim except voice message arrival notifying signal contains information about a caller. However, Amin teaches in an analogous art, that The portable cellular phone system according to claim 7, wherein said voice message arrival notifying signal contains information about a caller and said portable cellular phone has a function to display said information about said caller. (112; fig.2;

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col.5; 13-31, 40-47, & col.6; 43-57) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include voice message arrival notifying signal contains information about a caller in order to provide a voice mail notification to the subscriber.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharad Rampuria whose telephone number is 703-308-4736. The examiner can normally be reached on Mon-Fri. (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 703-308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Sharad Rampuria
June 29, 2004



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